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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/828,330	03/28/1997	WILLIAM D. MORGAN	I-852-002	4766

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EXAMINER

CANFIELD, ROBERT

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/828,330

Applicant(s)

MORGAN, WILLIAM D.

Examiner

Robert J Canfield

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-16 and 18-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-16 and 18-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. This Office action is response to the Request for Continued Examination filed 09/03/03 for application Serial Number 08/828330. Claims 1-12, 14-16, and 18-49 are pending. Claims 13 and 17 have been canceled.

2. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,400,549 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

3. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. No oath/declaration was received accompanying the amended claims in the Request for Consideration. As such no error has been identified.

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4. Claims 1-12, 14-16, and 18-49 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 18 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner fails to find any description of means for locking and unlocking or the step of locking and unlocking fasteners.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 5-7, 9-12, 14, 15, 18-20, 22, 24-29, 31-38, 40-42, 44, 47 and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,197,595 to Dearing.

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Dearing provides a cover for water or other liquids (Col. 1, line 9) The cover is adapted for use on ponds (Col. 1, line 34). The language "waste treatment pond cover" is nothing other than intended use. A pool is considered a "tank"

Further, applicant has admitted on record that tanks are known equivalents in the art to ponds. The cover is comprised of a plurality of panels 12 having means for linking and de-linking as well as locking and unlocking in the form of grommets 31 which may be tied together by fasteners of any suitable cord or other device (Col. 6, lines 66+). Dearing also provides means for anchoring and securing the panels 12 over the water in the form of straps 50, which are considered to meet the limitation of a "tie down cable". The water is considered dirty when the cover is used with a pond. The panels themselves provide a means for controlling temperature. Cells 16 provide air as insulation inside the panels.

9. Claims 5-7, 9, 10, 12, 14-16, 18, 19, 23, 25, 26, 28, 29, 31-33, 35-39, 41, 42, 46, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,590,714 to Walker.

Walker provides a plurality of rectangular panels 10, 10a, and means for linking and de-linking or locking and unlocking the panels in the form of vertically spaced grommets 41 and penetrating fasteners as shown in figure 3. The fasteners are shown having D rings which provide a means for securing or anchoring the cover.

The recitation "pond cover" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any

patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Recitations of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The limitations "waste treatment pond cover" and "for securing over dirty water" are considered intended use.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8, 21, 30 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent. 4,197,595 to Dearing.

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Dearing provides each of the elements of the claims as noted above except for the claimed panel dimensions and securing or anchoring to an anchoring trench. The claimed dimensions are viewed as nothing other than a choice of design, which would have been obvious at the time of the invention to one having ordinary skill in the art. Dearing recites preferred dimensions but suggests several dimensions are possible.

Applicant's Summary and Background of the Invention recites that it was known in the art at the time of the invention to secure pond covers to an anchoring such. As such, it would have been obvious at the time of the invention to one having ordinary skill in the art to have secured the cover assembly of Dearing to an anchoring trench when used in a pond environment.

12. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,590,714 to Walker.

Walker provides each of the elements of these claims except for the claimed panel dimensions, that the seams are welded, and the use of tie down cables to passing through the fastener to secure or anchor the cover.

The dimensions of the panels are nothing other than a choice of design, which would have been obvious at the time of the invention to one having ordinary skill in the art. It would have been obvious to one having ordinary skill in the art that the panels of Walker could be sized to meet any desired need.

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The examiner takes Official Notice that a welded seam is a known equivalent in the art to a stitched seam and to have substituted one known seam for another would have been an obvious choice of design to one having ordinary skill in the art at the time of the invention. It is nothing other the substitution of mechanical equivalents which do substantially the same thing.

The examiner takes Official Notice that it would have been obvious at the time of the invention to one having ordinary skill in the art the panels of Walker could have been anchored or secured in place by passing tie down cables through the D rings of the fasteners of figure 3. It is inherent or at least obvious that the rings are provided to provide a means for securing or anchoring and the use of cables and cords to anchor tarps is well known in the art.

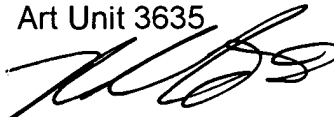
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J Canfield whose telephone number is 703-308-2482. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert J Canfield
Primary Examiner
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A handwritten signature in black ink, appearing to read 'RJC', is written over the printed name and title of the examiner.

09/02/04